



09/292,411.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Payne, et al

)

Attorney Docket No.: IPT-060.02

Patent No.: 6,753,172

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Issued: June 22, 2004

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For: FabI

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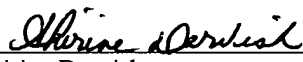


**CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8(a)**

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January 11, 2005

Date of Signature and of Mail Deposit

  
Shirine Darvish

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**Attention:** Decision and Certificate of Correction  
Branch of the Patent Issue Division

**Certificate**  
**JAN 24 2005**  
**of Correction**

**REQUEST FOR CERTIFICATE OF CORRECTION UNDER 37 C.F.R. §1.322**

Dear Sir:

Pursuant to 35 U.S.C. § 254 and 37 U.S.C. § 1.322, Applicants submit this Request for Certificate of Correction in the above-identified patent. Concurrent with this Request, Applicants submit two copies of PTO Form 1050. The complete Certificate of Correction contains one page.

The mistakes identified in the provided PTO Form 1050 are errors made by the United States Patent and Trademark Office. The claims of the above-identified patent were amended in the Examiner's Amendment to the Notice of Allowability mailed December 15, 2003 responding

JAN 2005

to the Applicant's Amendment mailed on September 22, 2003. The Examiner's Amendment mailed on December 15, 2003 and the Applicant's Amendment mailed on September 22, 2003 are provided as evidence showing the error is attributable solely to the Office (MPEP § 1480.01). Because Applicants have provided the necessary evidence, Applicants respectfully request expedited processing.

Since this correction was necessitated solely by Office error, Applicants do not believe that any fees are required for this correction. If a fee is nonetheless required, the Commissioner is hereby authorized to charge Deposit Account 06-1448, Ref. IPT-060.02.

Respectfully submitted,  
FOLEY HOAG LLP



---

Theresa C. Kavanaugh  
Reg. No. 50,356  
Agent for the Applicant

Date: January 11, 2005

**Customer No. 25181**  
Patent Group  
Foley Hoag LLP  
155 Seaport Blvd.  
Boston, MA 02210  
Tel: (617) 832-1000  
Fax: (617) 832-7000

## UNITED STATES PATENT AND TRADEMARK OFFICE

### CERTIFICATE OF CORRECTION

PATENT NO : 6,753,172

DATED : June 22, 2004

INVENTOR(S) : Payne et al.

It is certified that error appears in the above-identified patent and that said Letters Patent are hereby corrected as shown below:

In Claim 7, please replace lines 51-55

"comprises the amino acid at position 191 of SEQ ID NO:2, wherein said amino acid is glycine or a conservative substitution thereof, and wherein the polypeptide fragment comprises at least one biological activity of FabI." with

--is capable of reducing crotonyl-CoA or crotonyl-ACP.--

In Claim 9, please replace lines 62 (column 43)-lines 34 (column 44)

"comprises the amino acid at position 191 of SEQ ID NO: 2, wherein said amino acid is glycine or a conservative substitution thereof, and wherein the polypeptide fragment comprises at least one biological activity of FabI." with

--is capable of reducing crotonyl-CoA or crotonyl-ACP.--

In Claim 11, please replace lines 41-47

"that hybridizes under stringent conditions to the complementary strand of a polynucleotide having SEQ ID NO: 1 wherein said polypeptide is capable of reducing crotonyl-CoA or crotonyl-ACP and wherein said polypeptide comprises the amino acid sequence at position 191 of SEQ ID NO: 2, or its equivalent, and said amino acid is glycine or a conservative substitution thereof." with

--having at least 95% identity with the polynucleotide sequence set forth in SEQ ID NO: 1 wherein said polypeptide is capable of reducing crotonyl-CoA or crotonyl-ACP.--

In Claim 12, please delete lines 52-56

"wherein said polypeptide comprises the amino acid at position 191 of SEQ ID NO: 2, wherein said polypeptide is capable of reducing crotonyl-CoA or crotonyl-ACP, or its equivalent, and said amino acid is glycine or a conservative substitution thereof."

In Claim 13, please delete lines 60-63

"wherein said polypeptide comprises the amino acid at position 191 of SEQ ID NO: 2, or its equivalent, and said amino acid is glycine or a conservative substitution thereof."

MAILING ADDRESS OF SENDER: Foley Hoag, LLP  
Seaport World Trade Center West  
155 Seaport Boulevard  
Boston, MA 02210-2600

PATENT NO. 6,753,172

No. of additional copies:

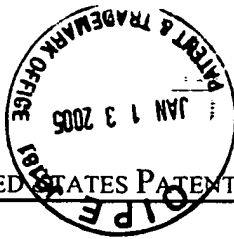


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This collection of information is required by 37 CFR 1.322, 1.323, and 1.324. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 1.0 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Attention Certificate of Corrections Branch, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

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## NOTICE OF ALLOWANCE AND FEE(S) DUE

25181 7590 12/15/2003  
FOLEY HOAG, LLP  
PATENT GROUP, WORLD TRADE CENTER WEST  
155 SEAPORT BLVD  
BOSTON, MA 02110

*Issue Fee*  
DOCKETED

DUE:

*3.15.04*  
*\* Confirm correct spelling of Title*

EXAMINER

NAVARRO, ALBERT MARK

ART UNIT

PAPER NUMBER

1645

DATE MAILED: 12/15/2003

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/292,411      | 04/15/1999  | DAVID J. PAYNE       | GM50005-D1          | 3526             |

TITLE OF INVENTION: NOVEL FABI

**COPY**

| APPLN. TYPE    | SMALL ENTITY | ISSUE FEE | PUBLICATION FEE | TOTAL FEE(S) DUE | DATE DUE   |
|----------------|--------------|-----------|-----------------|------------------|------------|
| nonprovisional | NO           | \$1330    | \$0             | \$1330           | 03/15/2004 |

THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. **PROSECUTION ON THE MERITS IS CLOSED.** THIS NOTICE OF ALLOWANCE IS NOT A GRANT OF PATENT RIGHTS. THIS APPLICATION IS SUBJECT TO WITHDRAWAL FROM ISSUE AT THE INITIATIVE OF THE OFFICE OR UPON PETITION BY THE APPLICANT. SEE 37 CFR 1.313 AND MPEP 1308.

THE ISSUE FEE AND PUBLICATION FEE (IF REQUIRED) MUST BE PAID WITHIN THREE MONTHS FROM THE MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. THIS STATUTORY PERIOD CANNOT BE EXTENDED. SEE 35 U.S.C. 151. THE ISSUE FEE DUE INDICATED ABOVE REFLECTS A CREDIT FOR ANY PREVIOUSLY PAID ISSUE FEE APPLIED IN THIS APPLICATION. THE PTOL-85B (OR AN EQUIVALENT) MUST BE RETURNED WITHIN THIS PERIOD EVEN IF NO FEE IS DUE OR THE APPLICATION WILL BE REGARDED AS ABANDONED.

### HOW TO REPLY TO THIS NOTICE:

#### I. Review the SMALL ENTITY status shown above.

If the SMALL ENTITY is shown as YES, verify your current SMALL ENTITY status:

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If the SMALL ENTITY is shown as NO:

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B. If applicant claimed SMALL ENTITY status before, or is now claiming SMALL ENTITY status, check the box below and enclose the PUBLICATION FEE and 1/2 the ISSUE FEE shown above.

☐ Applicant claims SMALL ENTITY status.  
See 37 CFR 1.27.

II. PART B - FEE(S) TRANSMITTAL should be completed and returned to the United States Patent and Trademark Office (USPTO) with your ISSUE FEE and PUBLICATION FEE (if required). Even if the fee(s) have already been paid, Part B - Fee(s) Transmittal should be completed and returned. If you are charging the fee(s) to your deposit account, section "4b" of Part B - Fee(s) Transmittal should be completed and an extra copy of the form should be submitted.

III. All communications regarding this application must give the application number. Please direct all communications prior to issuance to Mail Stop ISSUE FEE unless advised to the contrary.

**IMPORTANT REMINDER:** Utility patents issuing on applications filed on or after Dec. 12, 1980 **require** payment of maintenance fees. It is patentee's responsibility to ensure timely payment of maintenance fees when due.

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INSTRUCTIONS: This form should be used for transmitting the ISSUE FEE and PUBLICATION FEE (if required). Blocks 1 through 4 should be completed where appropriate. All further correspondence, including Patent, advance orders and notification of maintenance fees will be mailed to the current correspondence address as indicated unless corrected below or directed otherwise in Block 1, by (a) specifying a new correspondence address; and/or (b) indicating a separate "FEE ADDRESS" for maintenance fee notifications.

CURRENT CORRESPONDENCE ADDRESS (Note: Legibly mark-up with any corrections or use Block 1)

25181

7590

12/15/2003

FOLEY HOAG, LLP  
 PATENT GROUP, WORLD TRADE CENTER WEST  
 155 SEAPORT BLVD  
 BOSTON, MA 02110

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I hereby certify that this Fee(s) Transmittal is being deposited with the United States Postal Service with sufficient postage for first class mail in an envelope addressed to the Mail Stop ISSUE FEE address above, or being facsimile transmitted to the USPTO, on the date indicated below.

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|--------------------|
| (Depositor's name) |
| (Signature)        |
| (Date)             |

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/292,411      | 04/15/1999  | DAVID J. PAYNE       | GM50005-D1          | 3526             |

TITLE OF INVENTION: NOVEL FABI

| APPLN. TYPE    | SMALL ENTITY | ISSUE FEE | PUBLICATION FEE | TOTAL FEE(S) DUE | DATE DUE   |
|----------------|--------------|-----------|-----------------|------------------|------------|
| nonprovisional | NO           | \$1330    | \$0             | \$1330           | 03/15/2004 |

| EXAMINER             | ART UNIT | CLASS-SUBCLASS |
|----------------------|----------|----------------|
| NAVARRO, ALBERT MARK | 1645     | 435-183000     |

1. Change of correspondence address or indication of "Fee Address" (37 CFR 1.363).

- ☐ Change of correspondence address (or Change of Correspondence Address form PTO/SB/122) attached.
- ☐ "Fee Address" indication (or "Fee Address" Indication form PTO/SB/47; Rev 03-02 or more recent) attached. Use of a Customer Number is required.

2. For printing on the patent front page, list (1) the names of up to 3 registered patent attorneys or agents OR, alternatively, (2) the name of a single firm (having as a member a registered attorney or agent) and the names of up to 2 registered patent attorneys or agents. If no name is listed, no name will be printed.

|   |       |
|---|-------|
| 1 | _____ |
| 2 | _____ |
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## 3. ASSIGNEE NAME AND RESIDENCE DATA TO BE PRINTED ON THE PATENT (print or type)

PLEASE NOTE: Unless an assignee is identified below, no assignee data will appear on the patent. Inclusion of assignee data is only appropriate when an assignment has been previously submitted to the USPTO or is being submitted under separate cover. Completion of this form is NOT a substitute for filing an assignment.

(A) NAME OF ASSIGNEE

(B) RESIDENCE: (CITY and STATE OR COUNTRY)

Please check the appropriate assignee category or categories (will not be printed on the patent); ☐ individual ☐ corporation or other private group entity ☐ government

## 4a. The following fee(s) are enclosed:

- ☐ Issue Fee
- ☐ Publication Fee
- ☐ Advance Order - # of Copies \_\_\_\_\_

## 4b. Payment of Fee(s):

- ☐ A check in the amount of the fee(s) is enclosed.
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- ☐ The Director is hereby authorized by charge the required fee(s), or credit any overpayment, to Deposit Account Number \_\_\_\_\_ (enclose an extra copy of this form).

Director for Patents is requested to apply the Issue Fee and Publication Fee (if any) or to re-apply any previously paid issue fee to the application identified above.

(Authorized Signature)

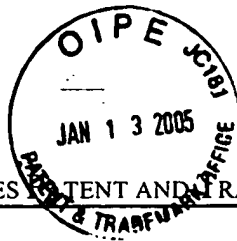
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This collection of information is required by 37 CFR 1.311. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, Alexandria, Virginia 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, Alexandria, Virginia 22313-1450.

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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.  | CONFIRMATION NO. |
|--|-------------|----------------------|----------------------|------------------|
| 09/292,411   | 04/15/1999  | DAVID J. PAYNE       | GM50005-D1           | 3526             |
| 25181  | 7590        | 12/15/2003           | EXAMINER             |                  |
| FOLEY HOAG, LLP<br>PATENT GROUP, WORLD TRADE CENTER WEST<br>155 SEAPORT BLVD<br>BOSTON, MA 02110 |             |                      | NAVARRO, ALBERT MARK |                  |
|  |             |                      | ART UNIT             | PAPER NUMBER     |
|  |             |                      | 1645                 |                  |

DATE MAILED: 12/15/2003

**Determination of Patent Term Extension under 35 U.S.C. 154 (b)**  
(application filed after June 7, 1995 but prior to May 29, 2000)

The Patent Term Extension is 386 day(s). Any patent to issue from the above-identified application will include an indication of the 386 day extension on the front page.

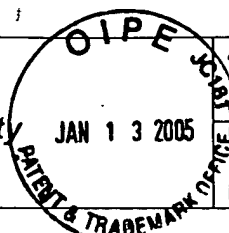
If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date that determines Patent Term Extension is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retrieval (PAIR) system (<http://pair.uspto.gov>).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (703) 305-1383. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at (703) 305-8283.

**Notice of Allowability**

JAN 13 2005



Application No.

09/292,411

Examiner

Mark Navarro

Applicant(s)

PAYNE ET AL.

Art Unit

1645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☐ This communication is responsive to \_\_\_\_\_.
2. ☐ The allowed claim(s) is/are 25-37, renumbered as claims 1-13, respectively.
3. ☐ The drawings filed on \_\_\_\_\_ are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☐ All    b) ☐ Some\*    c) ☐ None    of the:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
- \* Certified copies not received: \_\_\_\_\_.
5. ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
  - (a) ☐ The translation of the foreign language provisional application has been received.
6. ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application. **THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

7. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
8. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
  - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
    - 1) ☐ hereto or 2) ☐ to Paper No. \_\_\_\_\_.
  - (b) ☐ including changes required by the proposed drawing correction filed \_\_\_\_\_, which has been approved by the Examiner.
  - (c) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No. \_\_\_\_\_.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the margin according to 37 CFR 1.121(d).

9. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

- |   |  |
|---|--|
| 1 <input type="checkbox"/> Notice of References Cited (PTO-892)   | 5 <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2 <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 6 <input type="checkbox"/> Interview Summary (PTO-413), Paper No. _____    |
| 3 <input checked="" type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),<br>Paper No. <u>10/30/03</u> | 7 <input checked="" type="checkbox"/> Examiner's Amendment/Comment         |
| 4 <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit<br>of Biological Material                     | 8 <input type="checkbox"/> Examiner's Statement of Reasons for Allowance   |
|   | 9 <input type="checkbox"/> Other   |

### **EXAMINER'S AMENDMENT**

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Jennifer Holmes on December 4, 2003.

The application has been amended as follows:

#### **SPECIFICATION**

Page 1, line 1. Applicants preliminary amendment to the continuing data statement was updated as follows. After the phrase "filed January 28, 1997" the phrase —which claims benefit of US Provisional Application 60/024845, filed August 28, 1996—was inserted.

#### **CLAIMS**

Claim 34. The phrase "claim 35" was deleted and the phrase —claim 33—was inserted.

Claim 35. After the phrase "SEQ ID NO: 1" the phrase —wherein said polypeptide is capable of reducing crotonyl-CoA or crotonyl-ACP—was inserted.

Claim 36. After the phrase "SEQ ID NO: 2" the phrase —wherein said polypeptide is capable of reducing crotonyl-CoA or crotonyl-ACP—was inserted.

Claim 37. After the phrase "amino acid substitutions" the phrase —wherein said polypeptide is capable of reducing crotonyl-CoA or crotonyl-ACP—was inserted.



Art Unit: 1645

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Navarro whose telephone number is (703) 306-3225.

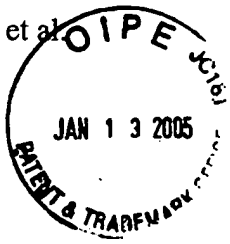
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith can be reached on (703) 308-3909. The fax phone number for the organization where this application or proceeding is assigned is 703 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.



Mark Navarro  
Primary Examiner  
December 4, 2003

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

|                                       |   |                                 |
|---------------------------------------|---|---------------------------------|
| In re the application of: Payne et al |  | Group Art Unit: 1645            |
| Serial No.: 09/292,411                |   | Examiner: A. Navarro            |
| Filing Date: April 15, 1999           |   | Attorney Docket No.: IPT-060.02 |
| For: <i>Fab I</i>                     |   |                                 |

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| <u>September 22, 2003</u><br>Date of Signature and Mail Deposit   | By: <u>Kristen Willett</u><br>Kristen Willett |

**RESPONSE AND AMENDMENT**

Dear Examiner Navarro:

In response to the Office Action, issued April 22, 2003, in the above-identified patent application, Applicants respectfully submit this Response and Amendment. Please amend the application as indicated herein. A Petition for a two-month extension of time is filed concurrently herewith. If any additional fees are due, the Commissioner is hereby authorized to charge them to Deposit Account Number 06-1448, Reference IPT-060.02.

# AMENDMENTS TO THE CLAIMS

Claims 1-24 (canceled)

25. (previously presented) An isolated polypeptide comprising the amino acid sequence set forth in SEQ ID NO: 2.

26. (previously presented) A composition comprising the isolated polypeptide of claim 25 and an acceptable carrier.

27. (previously presented) The isolated polypeptide of claim 25, wherein the isolated polypeptide comprises a heterologous amino acid sequence fused to the amino acid sequence set forth in SEQ ID NO: 2.

28. (previously presented) A composition comprising the isolated polypeptide of claim 27 and an acceptable carrier.

29. (previously presented) The isolated polypeptide of claim 25, wherein the isolated polypeptide consists of the amino acid sequence set forth in SEQ ID NO: 2.

30. (previously presented) A composition comprising the isolated polypeptide of claim 29 and an acceptable carrier.

31. (currently amended) An isolated polypeptide fragment comprising at least 50 consecutive amino acids of SEQ ID NO: 2 wherein said polypeptide fragment ~~comprises the amino acid at position 191 of SEQ ID NO: 2, wherein said amino acid is glycine or a conservative substitution thereof, and wherein the polypeptide fragment comprises at least one biological activity of Fab I~~ is capable of reducing crotonyl-CoA or crotonyl-ACP.

32. (previously presented) The isolated polypeptide fragment of claim 31, wherein the isolated polypeptide fragment comprises a heterologous amino acid sequence fused to the at least 50 consecutive amino acids of SEQ ID NO: 2.

33. (currently amended) An isolated polypeptide fragment comprising at least 30 consecutive amino acids of SEQ ID NO: 2 wherein said polypeptide fragment ~~comprises the amino acid at position 191 of SEQ ID NO: 2, wherein said amino acid is glycine or a conservative substitution thereof, and wherein the polypeptide fragment comprises at least one biological activity of Fab I~~ is capable of reducing crotonyl-CoA or crotonyl-ACP.

34. (previously presented) The isolated polypeptide fragment of claim 35, wherein the isolated polypeptide fragment comprises a heterologous amino acid sequence fused to the at least 30 consecutive amino acids of SEQ ID NO: 2.

35. (currently amended) An isolated polypeptide, wherein said polypeptide comprises an amino acid sequence encoded by a polynucleotide ~~that hybridizes under stringent conditions to the complementary strand of a polynucleotide~~ having at least 95% identity with the polynucleotide sequence set forth in SEQ ID NO: 1 ~~and wherein said polypeptide comprises the amino acid at position 191 of SEQ ID NO: 2, or its equivalent, and said amino acid is glycine or a conservative substitution thereof.~~

36. (currently amended) An isolated polypeptide comprising an amino acid sequence having at least 95% identity with the amino acid sequence set forth in SEQ ID NO: 2, ~~wherein said polypeptide comprises the amino acid at position 191 of SEQ ID NO: 2, or its equivalent, and said amino acid is glycine or a conservative substitution thereof.~~

37. (currently amended) An isolated polypeptide, comprising an amino acid sequence comprising SEQ ID NO: 2 with 0 to 10 conservative amino acid substitutions, ~~wherein said polypeptide comprises the amino acid at position 191 of SEQ ID NO: 2, or its equivalent, and said amino acid is glycine or a conservative substitution thereof.~~

### **REMARKS**

Applicants gratefully acknowledge Examiner's allowance of claims 25-30. Claims 25-37 are pending in the application. Claims 31, 33, and 35-37 have been amended. Support for the amendments and the new claims may be found throughout the specification. No new matter has been added.

In particular, support for the amendments to claims 31 and 33 may be found, for example, at page 42, lines 20-27. Support for the amendments to claim 35 may be found, for example at page 17, lines 19-23.

Amendment of claims should in no way be construed as an acquiescence to any of the Examiner's rejections. The amendments to the claims are being made solely to expedite prosecution of the present application and do not, and are not intended to, narrow the claims in anyway. Applicants reserve the option to further prosecute the same or similar claims in the instant or in a subsequent patent application.

#### **Rejection of claims 31-37 under 35 U.S.C § 112, first paragraph**

Claims 31-37 were rejected under 35 U.S.C. § 112, first paragraph, for reasons of written description. In particular, the Examiner alleges that the claims describe subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventors had possession of the invention at the time the application was filed. The rejection is respectfully traversed.

The Examiner states that claims 31-37 "recite a polypeptide comprising a fragment of SEQ ID NO: 2 comprising at least 30/50 amino acids." However, according to the Examiner, "the specification and claims do not indicate what distinguishing attributes are shared by the members of the genus." The Examiner further states that Applicants "have not described the function which is shared by the 30 consecutive amino acids of SEQ ID NO: 2 which would adequately describe the genus."

Applicants wish to note that claims 35-37 do not contain the language "comprising a fragment of SEQ ID NO: 2 comprising at least 30/50 amino acids." Accordingly, withdrawal of

the rejection of claims 35-37 is respectfully requested. Applicants will address the rejection only with respect to claims 31-34.

Applicants incorporate by reference their Response of April 3, 2003 which describes in detail the extensive teachings presented in the specification regarding structural and functional characteristics of FabI protein fragments. Additionally, while Applicants respectfully disagree with the rejection, the claims have been amended as suggested by the Examiner to identify a particular function shared by the members of the genus. In light of the remarks in the Response of April 3, 2003, and the claim amendments made herein, Applicants believe that the genus is adequately described. Accordingly, reconsideration and withdrawal of this rejection is respectfully requested.

**Rejection of claims 31-37 under 35 U.S.C § 112, first paragraph**

Claims 31-37 were rejected under 35 U.S.C. § 112, first paragraph, for allegedly containing new matter. Applicants respectfully disagree with the rejection, however, in an effort to expedite prosecution of the application, the objected to language has been canceled from the claims. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

**Rejection of claims 35-37 under 35 U.S.C. § 112, second paragraph**

Claim 35 was rejected under 35 U.S.C. § 112, second paragraph, for reasons of indefiniteness. In particular, the Office Action alleges that the claim is indefinite for recitation of “stringent hybridization conditions.” Applicants respectfully disagree with the rejection, however, in an effort to expedite prosecution of the application, the objected to language has been canceled from the claims. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

Claims 35-37 were rejected under 35 U.S.C. § 112, second paragraph, for reasons of indefiniteness. In particular, the Office Action alleges that the claims are indefinite for recitation of “SEQ ID NO: 2, or its equivalent...”. Applicants respectfully disagree with the rejection,

however, in an effort to expedite prosecution of the application, the objected to language has been canceled from the claims. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

**Rejection of claims 35-37 under 35 U.S.C. § 102(e)**

Claims 35-37 were rejected under 35 U.S.C. § 102(e) as being anticipated by Bailey et al. (U.S. Patent No. 6,403,337). The Office Action states that Bailey et al. "discloses a polypeptide of SEQ ID NO: 6 from *Staphylococcus aureus*" and teaches of "acceptable carriers for compositions and fusions with heterologous proteins (columns 102-111)." The Action further states that "SEQ ID NO: 6 comprises amino acid residues 1-256 that are 99.5% identical over amino acid residues 1-256 of SEQ ID NO: 1 as instantly claimed."

The rejection is respectfully traversed.

At pages 4-5 of the Office Action, and as stated in previous actions, the Examiner alleges that Bailey et al. (U.S. Patent No. 6,403,337) has "full priority under 119(e) to provisional 60/009,861 filed January 5, 1996." However, the filing date of the parent application (e.g., U.S.S.N. 60/009,861) may only be used as the 35 U.S.C. §102(e) date if the parent application properly supports the subject matter used to make the rejection under 35 U.S.C. §102(e) (see MPEP § 706.02(f)(1)). Applicants have examined U.S.S.N. 60/009,861 and were unable to find any subject matter that Applicants believe properly supports the current rejection. If the Examiner wishes to maintain this rejection, Applicants request that the Examiner point out with specificity the subject matter in U.S.S.N. 60/009,861 which supports the current rejection, including, for example, SEQ ID NO: 6 from U.S. Patent No. 6,403,337. In the absence of such a showing, Applicants assert that U.S. Patent No. 6,403,337 is not a proper reference under 35 U.S.C. § 102(e) because the earliest priority date for that patent which supports the subject matter used to make this rejection will fall after Applicants' earliest filing date (August 28, 1996). Accordingly, reconsideration and withdrawal of the rejection is respectfully requested absent a showing by the Examiner to the contrary.

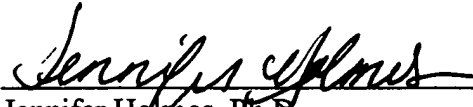
**Conclusion**

In view of the above remarks and the amendments to the claims, it is believed that this application is in condition for allowance. If a telephone conversation with Applicant's Attorney would expedite prosecution of the above-identified application, the Examiner is urged to call the undersigned at (617) 832-1000.

Respectfully submitted,

**Customer No. 25181**

Patent Group  
FOLEY, HOAG LLP  
155 Seaport Blvd.  
Boston, MA 02210-2600  
Telephone: (617) 832-1000  
Facsimile: (617) 832-7000

By:   
Jennifer Holmes, Ph.D.  
Reg. No. 46,778  
Agent for Applicants

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